

REMARKS

Claims 1-9 were pending. The Examiner rejected claims 1-8 and withdrew claim 9 from consideration as drawn to a non-elected group. Applicants have herein amended claims 1-2, and cancelled claims 3-9 without prejudice to further prosecution in one or more continuing or divisional applications. The amendments to the claims find support in the specification, including in the elected compound (SCOP 401) described in Example 47. Accordingly, no new matter has been added. Claims 1 and 2 are now pending.

In light of the amendments and the remarks herein, Applicants respectfully request reconsideration and allowance of the pending claims.

Rejections under 35 U.S.C. § 112, First Paragraph (Written Description and Enablement)

Claims 1-8 were rejected as allegedly failing to comply with the written description and enablement requirements. According to the Examiner, the specification fails to demonstrate possession of and fails to provide sufficient guidance as to how to make and use the wide range of variants encompassed by the pending claims.

While not acquiescing in the rejections, Applicants have amended claims 1 and 2 to encompass the elected compound SCOP 401 and certain homologs thereof (*e.g.*, compounds wherein a hydrogen atom is substituted with a methyl group). Example 47 (SCOP 401) is a representative species of the amended genus. Applicants respectfully submit that the amended claims therefore find more than adequate support in the present specification, and request withdrawal of the written description rejections.

With respect to enablement, Applicants respectfully disagree with the Examiner's characterization of the state of the art as it relates to the connection between histone deacetylase inhibitors and cancer, autoimmune disorders, skin disease, and infectious diseases. Applicants refer the Examiner to the various citations disclosed in the Background section, *e.g.*, at pages 4-8. In order to expedite prosecution, and without acquiescing in the rejections, however, Applicants have cancelled claims directed to pharmaceutical preparations, and have amended claim 2 to recite "*in vitro* histone deacetylase inhibitors." Accordingly, the pending claims are

fully enabled by the specification as filed. Applicants respectfully request withdrawal of the enablement rejections.

Rejections under 35 U.S.C. § 102(b)

The Examiner rejected claims 1-8 as allegedly anticipated by Rich *et al.* (Oncogene 2002) ("hereinafter Rich"). Applicants respectfully disagree with respect to the claims as amended, as Rich discloses no compounds that fall within the presently claimed genus. Accordingly, Rich cannot anticipate the present claims. Withdrawal of the rejections is respectfully requested.

Applicant : Minoru Yoshida et al.
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CONCLUSION

Applicants respectfully assert that the present claims are in condition for allowance, which action is hereby requested. The Examiner is invited to telephone the undersigned attorney if such would expedite prosecution.

Enclosed is a Petition for Extension of Time and fee for the Petition for Extension of Time (1 month). Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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